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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/033,457      | 12/27/2001  | Dennis E. Smith      | 82987AEK            | 8364             |

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01/31/2005

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/033,457

Applicant(s)

SMITH ET AL.

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-19,21,22,24-40,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-19,21,22,24-40,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12-10-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The Request for Reconsideration filed November 3, 2004 has been received and considered by Examiner.

***WITHDRAWN REJECTIONS***

2. The 35 U.S.C. 112, first paragraph, rejection of claims 1, 21 and 42 made of record in paragraph 8 of the previous Office Action mailed August 4, 2004 has been withdrawn due to Applicant's arguments presented on pages 1-4 of the Request for Reconsideration: Applicant correctly argues that the recitation that (solely) the microbeads have the claimed change in b\* value ("less than or equal to 0.2") is supported since the specification as originally filed states that "... the monomers from which the second polymer is derived are selected to provide microbeads that are both low-yellowing and thermally stable" (page 4, lines 4-6) and defines "low-yellowing" as having a change in b\* value that is "not more than 0.2" (equivalently, "less than or equal to 0.2" as claimed, page 4, lines 27-28).

***WITHDRAWN OBJECTIONS***

3. The objection to the specification made of record in paragraph 6 of the previous Office Action mailed August 4, 2004 has been withdrawn due to Applicant's arguments presented on pages 1-4 of the Request for Reconsideration as discussed above in regard to the 35 U.S.C. 112, first paragraph, rejection of claims 1, 21 and 42 made of record in paragraph 8 of the previous Office Action mailed August 4, 2004.

***REPEATED REJECTIONS***

4. The 35 U.S.C. 103(a) rejection of claims 1, 2, 5, 7, 9-19, 21, 22, 24-26 and 28-39 that was repeated in paragraph 3 of the previous Office Action mailed August 4, 2004 has been repeated for the reasons previously made of record.

5. The 35 U.S.C. 103(a) rejection of claims 8 and 27 that was repeated in paragraph 4 of the previous Office Action mailed August 4, 2004 has been repeated for the reasons previously made of record.

6. The 35 U.S.C. 103(a) rejection of claim 40 that was repeated in paragraph 5 of the previous Office Action mailed August 4, 2004 has been repeated for the reasons previously made of record.

7. The 35 U.S.C. 103(a) rejection of claims 42 and 43 made of record in paragraph 9 of the previous Office Action mailed August 4, 2004 has been repeated for the reasons previously made of record.

***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments regarding the applicability of Narita et al. in the 35 U.S.C. 103(a) rejection of claims 1, 2, 5, 7, 9-19, 21, 22, 24-26 and 28-39 over Maier et al. in view of Narita et al. provided on pages 4-5 of the Request for Reconsideration have been fully considered but are not persuasive. Applicant argues that "there is no teaching, disclosure, or suggestion in Narita et al. of incorporating microbeads resistant to yellowing into the dye receptor layer to control yellowing", but the microbeads of Maier et al., the primary reference, are microbeads of acrylates (i.e. polyacrylates) as made of record in previous Office Actions, and Narita et al. teach that an exemplary polymeric material of the layer in which coloring material is incorporated (i.e.

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the dye receptor layer) is a polyacrylate resin (or styrene/acrylic copolymer resin, col. 9, lines 21-29), so one of ordinary skill in the art would have recognized to have modified, e.g., the polyacrylate of the microbeads of Maier et al. as proposed in previous Office Actions since Narita et al. teaches that the coloring material is incorporated in a polyacrylate resin.

9. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of claims 42 and 43 over Maier et al. in view of Harrison et al. and in further view of Narita et al. provided on pages 5-6 of the Request for Reconsideration have been fully considered but are not persuasive. Applicant argues that Harrison et al. "does not disclose or suggest that the microbeads have [the claimed change in  $b^*$  value]", but the previous Office Action mailed August 4, 2004 does not state that Harrison et al. does disclose or suggest this. Narita et al. is relied upon to address the claimed change in  $b^*$ . The remainder of Applicant's arguments have been addressed above in the answer to Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of claims 1, 2, 5, 7, 9-19, 21, 22, 24-26 and 28-39 over Maier et al. in view of Narita et al.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

01/27/05 WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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